

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--|---|------------------------------|
| In Re U.S. Patent No. 7,363,436        | ) |                              |
| Issue Date: April 22, 2008             | ) | Group Art Unit: 2189         |
| Inventor: Tzong-Kwang Henry YEH et al. | ) | Examiner: Horace L. FLOURNOY |
| Application No.: 10/808,253            | ) | Conf. No. 4222               |
| Filed: March 23, 2004                  | ) |                              |
| For: COLLISION DETECTION IN A          | ) |                              |
| MULTI-PORT MEMORY SYSTEM               | ) |                              |

**Mail Stop Petition**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER  
OF THE REQUIREMENT UNDER 37 C.F.R. § 1.705(d)**

Pursuant to 37 C.F.R. § 1.183, Patentee petitions the Commissioner to waive the requirements of 37 C.F.R. § 1.705(d) that any request for reconsideration of the patent term adjustment indicated in an issued patent must be filed within two months of the date the patent issues. The required fee of \$400.00 for the petition under 37 C.F.R. § 1.183 is enclosed.

The U.S. Patent Trademark Office (USPTO) issued the above-referenced U.S. Patent No. 7,363,436 (the '436 patent) on April 22, 2008, with a patent term adjustment (PTA) of 0 days. Subsequently, on September 30, 2008, U.S. District Court for the District of Columbia ruled in *Wyeth v. Dudas* that the USPTO had made an error in the manner it determined PTA. Specifically, the court's decision relates to situations in which separate time periods of PTA

accrue due to PTO examination delay and those time periods do not overlap. The court ruled that in such situations, the PTA should be determined as the sum of the term adjustments of the respective separate time periods, rather than the greater one of the term adjustments, the latter practice being the PTO's manner of PTA determination used to date.

Patentee requests waiver of Rule 1.705(d) to permit filing and consideration of the accompanying Determination of Patent Term Adjustment - Post Grant, in which patentee requests a change in the PTA based on determination in a manner consistent with the court's decision referred to above.

This Petition is accompanied by the required petition fee of \$400.00, as set forth in 37 C.F.R. § 1.17(f). If there are any other fees due in connection with the filing of this Petition, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP.

*Donald D. Kinder, Jr.*  
Donald D. Kinder, Jr.

Dated: October 17, 2008

By: *Reg. No. 57,460*

*for* Gary J. Edwards  
Reg. No. 41,008  
650.849.6600

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| Filed: March 23, 2004                                      | ) |                              |
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| For: COLLISION DETECTION IN A MULTI-<br>PORT MEMORY SYSTEM | ) |                              |
|  | ) |                              |
| <b>Commissioner for Patents</b>                            |   |                              |
| <b>P.O. Box 1450</b>                                       |   |                              |
| <b>Alexandria, VA 22313-1450</b>                           |   |                              |

Sir:

**DETERMINATION OF PATENT TERM ADJUSTMENT - POST GRANT**

The Office issued the subject U.S. Patent No. 7,363,436 (the '436 patent) with a patent term adjustment of 0 days. The Application was filed on March 23, 2004. The first Office Action on the merits was dated March 24, 2006, creating a U.S. Patent and Trademark Office (USPTO) delay of 305 days. A response to the March 24, 2006. Office Action was filed September 25, 2006, creating an Applicant delay of 94 days. The patent application was allowed on May 1, 2007 with a requirement that formal drawing be submitted. The issue fee was paid on July 27, 2008. This case became abandoned on August 2, 2007 for the alleged failure to submit formal drawings. Applicants filed a Petition to Withhold Abandonment on October 1, 2007, which included copies of the Office Action mailed March 24, 2006 (including a form PTO-892, and a Form SB-08 initialed by the Examiner, and the Notice of Allowance mailed May 1, 2007), which erroneously created an Applicant delay of 120 days for an alleged late filing of an Information Disclosure Statement. The October 1, 2007

petition was denied in a Decision mailed February 6, 2008. Applicants filed a Petition to Revive an Unintentionally Abandoned Application, including formal drawings, on February 20, 2008, creating an Applicant delay of 63 days for the late submission of formal drawings. The February 20, 2008 Petition was granted in a decision mailed March 20, 2008, and the application was forwarded to the Publications Branch for issuance, creating an Applicant delay of 232 days.

The '436 patent issued on April 22, 2008. The three year pendency date for determination of patent term adjustment is March 23, 2007, thereby creating a USPTO delay of 396 days.

Patentee first submits that the alleged 120 day Applicant delay created by the filing of an Information Disclosure Statement on October 1, 2007 is incorrect, and should not be considered an Applicant delay because Applicant did not file an Information Disclosure Statement. Instead, Applicant filed the October 1, 2007 Petition which included as an attachment, a copy of the March 24, 2006 Office Action including its accompanying Form 892 and Form SB-08 initialed by the Examiner ("the Forms"). The Forms were then incorrectly entered into the USPTO's system as an Information Disclosure Statement, erroneously creating an Applicant delay of 120 days. Because the alleged delay was created by USPTO processing errors, the patentee is entitled to not have this erroneous delay count against any patent term that the patentee is otherwise entitled.

Moreover, in view of the decision of the Federal District Court for the District of Columbia in *Wyeth v. Dudas* on September 30, 2008, patentee submits it is entitled to a total patent term adjustment of 312 days which is the difference of the sum of 396

days of patent term adjustment due to exceeding three year pendency and 305 days due to US PTO delay in prosecution, and the 389 days created by Applicant delay<sup>1</sup>.

If there are any fees due in connection with the filing of this request, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

*Darrell D. Kinder, Jr.*  
Darrell D. Kinder, Jr.

Dated: October 17, 2008

By:

*Reg. No. 57,460*  
\_\_\_\_\_  
Gary J. Edwards

*for* Reg. No. 41,008

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<sup>1</sup> This delay includes the 94 day delay in responding to the March 24, 2006 Office Action, the 63 day delay for submitting formal drawings, and the 232 day delay in the acceptance of the issue fee and correcting other formal matters. The alleged 120 day delay in submitting an Information Disclosure Statement on October 1, 2007 is not included, because, for the reasons presented above, this alleged delay was created through USPTO processing errors.